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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,340	10/17/2003	Yolla B. Levitt	58981US002	7082
32692	7590	05/04/2007		
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			EXAMINER KUGEL, TIMOTHY J	
			ART UNIT 1712	PAPER NUMBER
			NOTIFICATION DATE 05/04/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/687,340

Applicant(s)

LEVITT ET AL.

Examiner

Timothy J. Kugel

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-16 and 19-29 is/are pending in the application.
- 4a) Of the above claim(s) 25,27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-16,19-24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-4,7-16 and 19-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-4, 7-16 and 19-29 are pending as amended on 16 April 2007, claims 5, 6, 17 and 18 being cancelled. Claims 25 and 27-29 stand withdrawn from further consideration.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 April 2007 as been entered.

3. Since applicant has filed an RCE under 37 CFR 1.114 after the filing of a Notice of Appeal to the Board of Patent Appeals and Interferences (Board), but prior to a decision on the appeal, it has been treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. See MPEP 706.07(h) X.

4. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.

Response to Amendment

5. Applicant's amendment to the specification, filed 16 April 2007, with respect to the identification of Trademarks has been fully considered and are corrective.

The objection to the specification has been withdrawn.

6. Applicant's cancellation of claims 5, 6, 17 and 18 in the amendment filed 16 April 2007 renders the following rejections moot:

The rejection of claims 5 and 17 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over UK Patent GB 1235918 (Weigel hereinafter) has been withdrawn.

The rejection of claims 17 and 18 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over European Patent EP 1101803 (Kanno hereinafter) has been withdrawn.

7. Applicant's amendment, filed 16 April 2007, with respect to importing the limitations of the cancelled claims 5, 6, 17 and 18 into the independent claims—requiring the surfactant to be a non-ionic surfactant selected from the claimed Markush group of surfactants—has been fully considered and overcomes the prior art.

The rejection of claims 1, 4, 8-11, 13-16, 20, 21, 23, and 26 under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over UK Patent GB 1235918 (Weigel hereinafter) has been withdrawn.

The rejection of claims 15, 16, 20, 23, 24 and 26 under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over European Patent EP 1101803 (Kanno hereinafter) has been withdrawn.

Claim Rejections - 35 USC § 112

8. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "of claim 18". There is insufficient antecedent basis for this limitation in the claim as claim 18 has been cancelled. For the purpose of examination, claim 19 was construed to recite, "of claim 15".

Claim Rejections - 35 USC § 102

9. Claim 26 stands rejected under 35 USC 102(e) as anticipated by US Patent 6,908,453 (Fleming hereinafter).

Fleming teaches micro-needle devices comprising surfaces provided with a hydrophilic coating to enhance fluid transport provided by coating the desired surface or surfaces using a surfactant solution that includes from about 0.05% to about 0.5%, by weight, branched chain sodium dodecylbenzene sulfonate—the elected stabilizer—and from about 0.10% to about 0.6%, by weight, ethoxylated acetylenic diol—the elected surfactant—in a solvent including a 70/30 mix of isopropyl alcohol and water (Column 6

Lines 5-13). The dried coating composition calculates to a 0.2:1 to 12:1 ratio of surfactant to stabilizer.

Since Fleming teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the results of the Spreading Drop Test, the phase of the surfactant composition at below 25° C, the melting point of the stabilizer and the contact angle on the hydrophilic surface of the Fleming composition would inherently be the same as claimed.

Regarding the limitation, "wherein the surfactant composition is dried on the surface", while Fleming does not explicitly teach a drying step, since any un-dried coating composition would contaminate any fluid being transferred through the device, the coating composition must be dried prior to use.

The applied reference has a common assignee with the instant application. Based upon the earlier effective US filing date of the reference, it constitutes prior art under 35 USC 102(e). This rejection under 35 USC 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 103

10. Claims 1-24 and 26 are rejected under 35 USC § 103(a) as being unpatentable over US Patent 4,784,789 (Jeschke hereinafter) in view of 6,313,182 (Lassila hereinafter).

Jeschke teaches a composition for treating surfaces (Column 1 Lines 5-12) comprising 0.02 to 5% of an amphoteric polymer (Column 2 Lines 22-48)—including anionic surfactants such as ethoxylated alkenols (Column 3 Lines 19-25)—and a surfactant—including alkylbenzene sulfonates containing 9 to 15 carbons in the alkyl group and alkali metals thereof (Column 3 Lines 31-63) from this which, one of ordinary skill in the art would immediately envisage the alkali metal salt of dodecyl benzene sulfonate—in a 20:1 to 1:1 ratio (Column 2 Lines 22-37) dissolved in water and a water soluble solvent—including C₂-C₁₂ alcohols such as ethanol and isopropanol (Column 5 Lines 8-20 and Example 1 Columns 8 Lines 30-47). Further, Jeschke teaches that the composition is dried after application Column 7 Lines 29-38 and 54-58).

Jeschke does not disclose expressly the use of the elected acetylenic diol ethylene oxide adduct.

Lassila discloses coating compositions comprising acetylenic diol ethylene oxide adducts (Abstract, Column 1 Lines 10-30 and Column 1 Line 39 – Column 2 Line 10).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the acetylenic diol ethylene oxide adduct of Lassila in the composition of Jeschke. The motivation to do so would have been to take advantage of the significant advantages of the alkoxylated acetylenic diols including the ability to be applied to a variety of substrates, the ability to reduce coating defects, their environmental friendliness, and their capability to control foam (Lassila Column 6 Lines 29-55).

Since Jeschke and Lassila combine to teach the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the results of the Spreading Drop Test, the phase of the surfactant composition at below 25° C, the melting point of the stabilizer and the contact angle on the hydrophilic surface of the Jeschke/Lassila composition would inherently be the same as claimed.

Response to Arguments

11. Applicant's arguments filed 16 April 2007 have been fully considered but they are not persuasive.

Applicant argues that Fleming fails to teach drying the surfactant composition; however, while Fleming does not explicitly teach a drying step, since any un-dried coating composition would contaminate any fluid being transferred through the device, the coating composition must be dried prior to use.

Applicant further argues that the Examiner equates Jeschke's amphoteric polymer with the anionic surfactant claimed; however, the Examiner's pointing to the amphoteric surfactant of Jeschke is merely to show that Jeschke contemplates the use of more than one surfactant.

Applicant still further argues that there is nothing in Jeschke to suggest the functional parameters claimed; however, it is the combined teaching of Jeschke and Lassila of the same composition as claimed that would lead one of ordinary skill in the art at the time the invention was made to have expected that the results of the Spreading Drop Test, the phase of the surfactant composition at below 25° C, the

melting point of the stabilizer and the contact angle on the hydrophilic surface of the Jeschke/Lassila composition would inherently be the same as claimed. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant finally argues that Lassila teaches the use of acetylenic diol ethylene oxide adducts in place of nonionic and anionic surfactants; however, while Lassila may teach the superiority of the acetylenic diol ethylene oxide adducts taught there is no teaching that they should replace the nonionic and anionic surfactants. Further, even if Lassila taught a replacement of the nonionic and anionic surfactants with the acetylenic diol ethylene oxide adducts it has been held that it is prima facie obviousness to combine two components each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the same purpose. In *Re Kerkhoven*, 205 USPQ 1069, 1072 (CCPA 1980); and *Ex Parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday - Thursday.

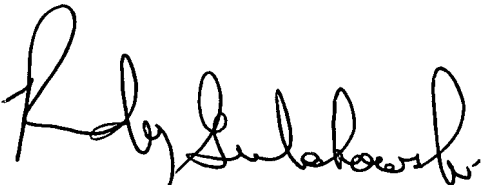
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJK
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